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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/193,787	11/17/1998	JAY PAUL DRUMMOND	D1077+1	2446

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EXAMINER

WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/193,787

Applicant(s)

DRUMMOND ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on December 17, 2004, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 10/980209. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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4. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 10957287. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-11 of copending Application No. 09/578291 in view of US Patent No. 4355369 to Garvin and US Patent NO. 09/578291 to Wagner.

Application No. 09/578291 teaches an automated banking machine, an output device, input device (automated banking machine reads card indicia) and a transaction function device.

Application No. 09/578291 does not expressly disclose a computer and HTML document.

Garvin teaches an ATM comprising a computer (see fig. 1, 16). Wagner discloses non-standard devices such as printers, magnetic card readers and pin pads (see col. 9, lines 56-col. 10, line 9), which can be operated by HTML documents (see col. 11, lines 1-24). Thus, it would have been

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obvious to modify Application No. 09/578291 to include a computer and HTML document because such modification makes the transaction system “available for the ever-expanding market available through the Internet” (see Wagner col. 6, lines 28-34), using devices, “which have not previously been able to couple to such open networks” (see Wagner col. 6, lines 16-20).

This is a provisional obviousness-type double patenting rejection.

7. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 25, 26 and 30 of copending Application No. 10/990334 in view of US Patent No. 4355369 to Garvin.

Application No. 10/990334 discloses a computer of an ATM, a transaction function device (cash dispenser), an output device (display screen) and a browser operative to process HTML documents (i.e. “browser generating an output through the display screen of the ATM responsive to the second HTML document). As for the input device, this is an inherent feature; that is, it is known in the art that ATM comprises input devices. Garvin exemplifies this inherency; notice, Garvin teaches an ATM with keyboards, card readers and depository (see fig. 2, 32 & fig. 1, 32).

8. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 25, 26 and 30 of copending Application No. 11/135948 in view of US Patent No. 4355369 to Garvin.

Application No. 11/135948 discloses a computer of an ATM, a transaction function device (cash dispenser), an output device (display screen) and a browser operative to process HTML documents (i.e. “browser generating an output through the display screen of the ATM

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responsive to the second HTML document). As for the input device, this is an inherent feature; that is, it is known in the art that ATM comprises input devices. Garvin exemplifies this inherency; notice, Garvin teaches an ATM with keyboards, card readers and depository (see fig. 2, 32 & fig. 1, 32).

9. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 9, and 11 of copending Application No. 11/033601 in view of US Patent No. 5742845 to Wagner.

Application No. 11/033601 discloses an automated banking machine, an input device (ATM reading card indicia), an output device, a transaction function device, the step of processing a first document with a browser and operating the transaction function device responsive to the at least one instruction in the first document. Application No. 11/033601 does not expressly disclose an HTML document. Wagner discloses non-standard I/O devices such as printers, magnetic card readers and pin pads, which can be operated by HTML documents. Thus, it would have been obvious to modify Application No. 11/033601 to include HTML documents because doing so makes the transaction system “available for the ever-expanding market available through the Internet” (see col. 6, lines 28-34) using devices “which have not previously been able to couple to such open networks” (see col. 6, lines 16-20).

This is a provisional obviousness-type double patenting rejection.

10. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 09/578312 in view of US Patent No. 4355369 to Garvin.

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Application No. 09/578312 discloses an automated banking machine, a computer, transaction function device, an output device and the computer is operative to cause the transaction function device to operate responsive to instruction in at least one document processed by at least one instance of the at least one browser, the document includes an HTML document. As for the input device, this is an inherent feature; that is, it is known in the art that ATM comprises input devices. Garvin exemplifies this inherency; notice, Garvin teaches an ATM with keyboards, card readers and depository (see fig. 2, 32 & fig. 1, 32).

This is a provisional obviousness-type double patenting rejection.

11. Claim 13 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/356849 in view of US Patent NO. 5742845 to Wagner.

Application No. 10/356849 discloses a computer in an ATM, a transaction function device (cash dispenser), an output device, and the function device is adapted to carry out a banking transaction (“operating the cash dispenser to dispense cash from the ATM”).

Application No. 10/356849 does not expressly disclose the banking transaction is carried out through operation of the at least one transaction function device responsive to at least one mark up language document. Wagner discloses non-standard I/O devices such as printers, magnetic card readers and pin pads (see col. 9, line 56 – col. 10, line 9) that can be operated by HTML documents. Thus, it would have been obvious to modify Application No. 10/356849 to include a banking transaction is carried out through operation of the at least one transaction function device responsive to at least one mark up language document because doing so makes the

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transaction system “available for the ever-expanding market available through the Internet” (see col. 6, lines 28-34) using devices “which have not previously been able to couple to such open networks (see col. 6, lines 16-20).

This is a provisional obviousness-type double patenting rejection.

12. Claim 13 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/357145 in view of US Patent No. 5742845 to Wagner.

Application No. 10/357145 discloses a computer in an ATM, a transaction function device (cash dispenser), an output device, and the function device is adapted to carry out a banking transaction (“operating the cash dispenser to dispense cash from the ATM”).

Application No. 10/357145 does not expressly disclose the banking transaction is carried out through operation of the at least one transaction function device responsive to at least one mark up language document. Wagner discloses non-standard I/O devices such as printers, magnetic card readers and pin pads (see col. 9, line 56 – col. 10, line 9) that can be operated by HTML documents. Thus, it would have been obvious to modify Application No. 10/357145 to include a banking transaction is carried out through operation of the at least one transaction function device responsive to at least one mark up language document because doing so makes the transaction system “available for the ever-expanding market available through the Internet” (see col. 6, lines 28-34) using devices “which have not previously been able to couple to such open networks (see col. 6, lines 16-20).

This is a provisional obviousness-type double patenting rejection.

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13. Claim 13 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 and 24 of copending Application No. 10/430123. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 10/430123 discloses an ATM including at least one computer at least one transaction function device (cash dispenser) in operative connection with the at least one computer, carrying out a banking transaction with the transaction function device responsive to processing at least one mark up language document with the computer (i.e. "the computer is operative to cause the cash dispenser to dispense cash responsive to at least one instruction included in at least one markup language document).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claim 13 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of copending Application No. 10/980345 in view of US Patent No. 4355369 to Garvin and US Patent No. 5742845 to Wagner.

Application No. 10/980345 discloses an automated banking machine including a transaction function device, at least one mark up language document with instructions adapted to cause the machine to operate the transaction function device. Application No. 10/980345 does not teach the step of processing at least one markup language document with a computer and a banking transaction with the transaction function device responsive to processing the at least one mark up language document with the computer. Garvin discloses an ATM comprising a computer (see fig. 1, 16). Wagner discloses non-standard I/O devices such as printers, magnetic card readers and pin pads (see col. 9, lines 56-col. 10, line 9) can be operated by HTML

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documents (see col. 11, lines 1-24). Thus, it would have been obvious to modify Application No. 10/980345 to include the step of processing at least one markup language document with a computer and a banking transaction with the transaction function device responsive to processing the at least one mark up language document with the computer because doing so makes the transaction system “available for the ever-expanding market available through the Internet (see col. 6, lines 28-34) using devices, “which have not previously been able to couple to such open networks” (see col. 6, lines 16-20).

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

16. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because this is a “single means claim”. “A means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those known to the inventor” (see MPEP 2164.08(a). Further, there are not distinct functions that make the device of claim 12 an ATM.

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites, "the transaction function device is operative to cause the ATM to carry out a transaction function", this phrase is confusing. Applicant is advised to amend this claim to clearly show what is doing the function.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for Regular/After Final Actions and (571)273-6714 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
P.O. Box 1450

Application/Control Number: 09/193,787

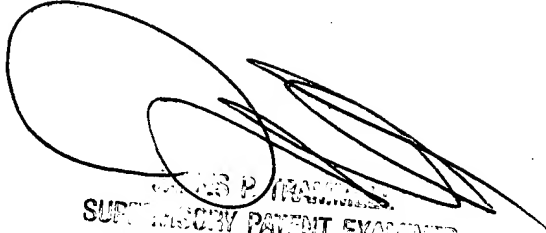
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Alexandria, VA 22313-1450

Jalatee Worjloh
Patent Examiner
Art Unit 3621

July 13, 2005



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